

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed February 17, 2005. Upon entry of this response, claims 1-3, 5, 6, 8, 9, 11, 12, 16, 17, 19-28, 30-33, 35-39, and 42-48 are pending in the application. In this response: claims 1, 5, 8, 11, 24, 30, 36, and 42 have been amended; claims 7, 10, 13, 18, 29, 34, 40, and 41 have been cancelled; and claims 49-56 have been added. Applicants respectfully request that the amendments being filed herewith be entered and that there be reconsideration of all pending claims.

1. Amendments to the Specification

The present application incorporates U.S. Patent Application Serial No. 09/118,106 by reference. Applicants have amended the specification to include additional material drawn from the incorporated patent application. Specifically, the new paragraphs added to the specification in this response substantially include the following material from 09/118,106: p. 11, lines 10-15; p. 13, lines 5-15; and p. 15 line 20 to p. 18, line 5. Because the present application incorporates 09/118,106 by reference, Applicants respectfully submit that these amendments to the specification do not represent new matter.

2. Amendments to the Drawings

A new figure, Figure 6, has been added. This drawing is substantially the same as Figure 4 in Application 09/118,106, which is incorporated by reference in the present application.

3. Claim Objections

The Office Action objects to claim 42, alleging that “the phrase ‘configured to’ is not a positive limitation.” The Office Action further explains that this phrase “renders the uncertainty of whether the function is actually being performed by the device it called for.” Applicant has

amended claim 42 to use “means for” language instead of the objected-to phrase “configured to,” and respectfully requests the objection to claim 42 be withdrawn.

4. Rejection of Claims 1-3, 5-13, and 16-48 under 35 U.S.C. §103

Claims 1-3, 5-13, and 16-48 have been rejected under §103(a) as allegedly obvious over *Ennis Jr. et al.* (U.S. 5,867,483) in view of *Schulman* (U.S. 5,600,632). Applicants respectfully traverse the rejection of claims 1-3, 5-13, and 16-48. Applicants respectfully submit that the rejection has been overcome by the claim amendments herein. It is well established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

a. Claims 1, 5, 8, 11, 24, 30, 36, and 42

Claim 1 has been amended to recite a “means for collecting, from a first and a second communication device...where said first and second communication device are each configured to couple at least one user device to the network” as recited in amended claim 1. Claims 5, 11, 24, 30, 36, and 42 have been amended to recite various other features describing ***communication devices configured to couple a user device to the network***. *Ennis Jr. et al.* does not disclose, teach, or suggest these features recited in amended claims 1, 5, 8, 11, 24, 30, 36, and 42.

Ennis Jr. et al. discloses a “system for measuring peak throughput in packetized data networks.” The system, as shown in Figure 1, includes a remote monitoring probe (12) which monitors network activity on a particular communications link (10, 11) between a site (A) and

packetized switching network 3. Console 16 communicates with probe 12 to gather network information. (Abstract; Col. 3, lines 40-65.)

Applicants will assume, *arguendo*, that the monitored site (A) contains some user devices. However, *Ennis Jr. et al.* does not describe, in text or figures, how these user devices connect to the network. There is certainly no suggestion or teaching in *Ennis Jr. et al.* that it is probe 12 which couples user devices to the network (3).

In contrast, in Applicants' invention, as defined by amended claims 1, 5, 8, 11, 24, 30, 36, and 42, various types of network performance information are collected from a first and second communication device. Amended claim 1 further recites that the "first and second communication device are each configured to couple at least one user device to the network." Amended claims, 11, 24, 30, 36, and 42 also recite features describing communication devices configured to couple a user device to the network.

Schulman discloses a plurality of synchronized network analyzers. Figure 3 shows several network analyzers (M). each of which is inserted into a link between two network devices. For example, one monitor is inserted into a communication link between a digital entertainment terminal (DET) and an optical network unit (ONU). Another monitor is inserted into a communication link between an infrared receiver and a DET.

Applicants will assume, *arguendo*, that a DET corresponds to a "user device" and a monitor corresponds to a "means for collecting." Even so, it is the ONU or the digital cross connect switch that couples the DET to the network, and not the probe.

Accordingly, the proposed combination of *Ennis Jr. et al.* in view of *Schulman* does not teach at least the above-described features recited in claims 1, 5, 8, 11, 24, 30, 36, and 42. Since the proposed combination does not teach at least the above-described features recited in claims 1,

5, 8, 11, 24, 30, 36, and 42, a *prima facie* case establishing an obviousness rejection has not been made. Thus, claims 1, 5, 8, 11, 24, 30, 36, and 42 is not obvious under the proposed combination of *Ennis Jr. et al.* in view of *Schulman*, and the rejection should be withdrawn.

b. Claims 2, 3, 6, 7, 9, 10, 12, 13, 16-23, 25-29, 31-35, 37-41, and 43-48

Since claims 1, 5, 8, 11, 24, 30, 36, and 42 are allowable, Applicants respectfully submit that claims 2, 3, 6, 7, 9, 10, 12, 13, 16-23, 25-29, 31-35, 37-41, and 43-48 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of claims 2, 3, 6, 7, 9, 10, 12, 13, 16-23, 25-29, 31-35, 37-41, and 43-48 be withdrawn.

5. Newly Added Claims

Applicants submit that new claims 49-56 are allowable over the cited references. New claims 49-56 are dependent claims. Independent claims 1, 5, 8, 11, 24, 30, 36, and 42 are allowable for at least the reasons argued above. Therefore, new claims 49-56 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Applicants request that the Examiner enter and allow the above new claims.

CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 1-3, 5, 6, 8, 9, 11, 12, 16, 17, 19-28, 30-33, 35-39, and 42-48 be allowed to issue. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,

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AMENDMENTS TO DRAWINGS

The attached sheet of drawings includes a new drawing, Figure 6.